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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,950	11/25/2003	Russell Alan Parker	10030712-1	9616

22878 7590 02/13/2006

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EXAMINER

PADGETT, MARIANNE L

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/722,950

Applicant(s)

PARKER ET AL.

Examiner

Marianne L. Padgett

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,16-18,27-29 and 53-55.
Claim(s) withdrawn from consideration: 2-11,14,15,25,26,40-52 and 56.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

MARIANNE PADGETT
PRIMARY EXAMINER

Continuation of 3. NOTE:

While new claims 57-62 mostly repeat limitations of the finally rejected claims, independent claim 57 requires the new limitation of "producing a sealed array assay chamber...", which has not been previously claimed. Old independent claims 1 & 53, while intending the treated gaskets for use in such a chamber, did not actually require such a use, only the capability of being effective therefore, hence these new claims require consideration of a new issue, as well as adding new claims without canceling a corresponding number of finally rejected claims.

Also with respect claim 57, it is uncertain how the "producing..." step is part of "treating a backing element...", to which the preamble says the claims subject matter is directed.

While claim 28 (hence also new claims 61) has been clarified, it does not actually say when or where or under what conditions "said treating allows said gasket to form a seal".

In new claims 60-62, note "said treating" must be considered to refer to "treating a backing element" in the preamble, which as claimed "comprises" both "surface modifying..." & "producing a sealed... chamber...", thus exactly how "said treating" relates to the steps of the independent claim, is not entirely clear.

Continuation of 5. Applicants' reply has overcome the following rejection(s):

The amendment to claim 28 clarifies the issue raised under 112, second paragraph in section 3 of the 11/2/2005 rejection, however it is noted the amendment does not necessarily relate the new limitation of "to form a seal" to the intended use as presented by the preamble, nor to the "surface modifying said gasket to treat said gasket", as "said treating..." only refers back to the preamble (line 1) due to antecedence and not necessarily any one particular procedure that may be accomplished under the overall method.

Continuation of 11. does NOT place the application in condition for allowance because:

The action mailed 11/2/2005 was based on applicants' amendment made 4/15/2005, which were made in response to the first action on the merits mailed 1/18/2005, hence making new grounds of rejection final due to an amendment made by applicant is entirely appropriate and applicants' arguments to the contrary are not convincing. That in intervening restriction(7/19/2005)/election (8/18/2005) was required does not affect this.

With respect to applicants' arguments concerning "a sealed array assay chamber", none of the examined claims positively require this limitation, as it is only present as an intended use, thus none of the references need actually be directed to array assay chambers and it is irrelevant whether the nozzles of the primary reference are sealed chambers or not. What is relevant is whether the gaskets formed by the combined references would be capable of sealing such chambers, which as discussed in the rejection of 11/2/2005, the gaskets' use for sealing is considered to demonstrate effectiveness therefore.

The proposed new claims 57- 62, which do positively require combination of the gasket with a sealed array chamber, require further consideration, such as whether one would be motivated to use gaskets, such as produced in the art rejection of section 8 of the 11/02/2005 action, to affect a seal for an array assay chamber, hence as pointed out above this is a new issue with respect to the claims.

